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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,269	02/20/2004	Goran OLSSON	07589.0154.PCUS00	2268
28694	7590	07/18/2006	EXAMINER	
NOVAK DRUCE & QUIGG, LLP 1300 EYE STREET NW 400 EAST TOWER WASHINGTON, DC 20005			TRIEU, THAI BA	
			ART UNIT	PAPER NUMBER
			3748	

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/708,269	<b>Applicant(s)</b> OLSSON ET AL.	
	<b>Examiner</b> Thai-Ba Trieu	<b>Art Unit</b> 3748	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/20 &amp; 08/19/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

The disclosure is objected to because of the following informalities:

- In Paragraph [0007], line 2, "**configured \* so that**" should be replaced by -- **configured so that** --.
- In Paragraph [0019], line 5, "**throttle 16**" should be replaced by -- **throttle 19** -- (*for correcting typo error*).

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 1 recites the limitation "**the steps**" in lines 17-18; "**the pressure regulator**" in lines 18. There are insufficient antecedent basis for this limitation in the claim.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **1 and 3** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,895,753 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims **1 and 4** of the patent "anticipate" application claims **1 and 3**. Accordingly, application claims **1 and 3** are not patentably distinct from patent claim **1 and 4**. Patent claims **1 and 4** requires the following elements:

- an exhaust turbine (15);
- an exhaust system having a supercharger turbine (11) that drives a compressor (13) for the engine combustion air;
- residual energy in the exhaust gas flow being recovered via the exhaust turbine (15) for transferring to the crankshaft of the internal combustion engine;
- the exhaust system comprising an exhaust brake throttle (16);

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- an exhaust gas pressure regulator (22) for regulating the exhaust brake pressure;

- the exhaust gas pressure regulator comprising:

- a piston valve (22);

- a first piston surface acted upon by the exhaust gas pressure when the exhaust braking throttle (16) is closed; and

- a second opposed piston surface (25) which is firmly connected to the first piston surface and is acted upon by the pressure in the compressed air line (28).

While in the instant application, claims 1 and 3 require elements:

- an exhaust system ...;

- a supercharger turbine (11) that drives a compressor (13) for the engine combustion air;

- an exhaust turbine (15);

- residual energy from an exhaust flow of the engine, via transmission to the combustion engine's crankshaft;

- the exhaust system further comprising an exhaust brake throttle (16);

- an exhaust gas pressure regulator (22) being providing with means for adapting the exhaust brake pressure to the engine speed;

- the exhaust gas pressure regulator comprising:

- a piston valve (22);

a first piston surface acted upon by the exhaust gas pressure when the exhaust braking throttle (16) is closed; and

a second opposed piston surface (25) which is permanently connected to the first piston surface, which second piston surface is acted upon by a control pressure.

Thus it is apparent that the more specific patent claims 1 and 4 encompass application claims **1 and 3**. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claims **1 and 3** are anticipated by Patent claim **1 and 4** and since anticipation is the epitome of obviousness, then Application claims **1 and 3** are obvious over Patent claim **1 and 4**.

Claim 2 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,895,753 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claim 2 requires the exhaust brake throttle (16) comprising an exhaust throttle valve (19) located in the exhaust system downstream.

However, the patent claim 2 fails to disclose the location of an exhaust throttle valve located in the exhaust system downstream of the exhaust turbine and a parallel bypass regulated by the exhaust gas pressure regulator.

Larsson (Patent Number 6,895,753 B2) teaches that it is conventional in the exhaust turbine apparatus art, to utilize the location of an exhaust throttle valve (19) located in the exhaust system downstream of the exhaust turbine (15) and a parallel bypass (21) regulated by the exhaust gas pressure regulator (22) (See Figures 1 and 3).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized the location of an exhaust throttle valve located in the exhaust system downstream of the exhaust turbine and a parallel bypass regulated by the exhaust gas pressure regulator, as taught by Larsson, to improve the performance efficiency of the turbo-compound type internal combustion engine.

***Allowable Subject Matter***

Claim 4 is allowed.

***Conclusion***

The IDS(s) (PTO-1449) filed on February 20 and August 19, 2004 have been considered. Each initialized copy is attached hereto.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Håkansson (US Patent Number 6,085,525) discloses a valve for varying the exhaust counter-pressure in an internal combustion engine.
- Hatanaka (US Patent Number 4,884,407) discloses a turbo-compound engine.

- Okada (US Patent Number 4,843,822) discloses a turbo-compound engine.
- Okada et al. (US Patent Number 4,800,726) discloses a turbo-compound engine.
- Newton (US Patent Number 2,622,390) discloses a control apparatus including an auxiliary power recovery turbine for turbo-supercharged engines.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai-Ba Trieu whose telephone number is (571) 272-4867. The examiner can normally be reached on Monday - Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

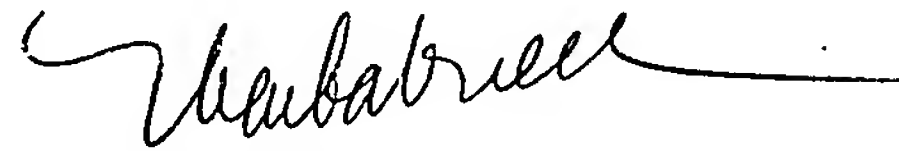
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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TTB  
July 08, 2006



Thai-Ba Trieu  
Primary Examiner  
Art Unit 3748